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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IN RE APPLICATION OF : Michael J. Sullivan
FOR : IMPROVED MULTI-LAYER
GOLF BALL
SERIAL NO. : 08/815,556
FILED : March 12, 1997
EXAMINER : M. Graham
ART UNIT : 3304
LAST OFFICE ACTION : October 22, 1997
ATTORNEY DOCKET NO. : SLD 2 035-1-1
February 5, 1999
Cleveland, Ohio 44114

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TECHNOLOGY CENTER 3700

Reply Brief Transmittal

Box AF
Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

Enclosed for filing in the above-identified application is Applicant's Reply
Brief, in triplicate.

Please charge any fee deficiencies or credit any overpayment to Deposit
Account No. 06-0308.

Respectfully submitted,
FAY, SHARPE, BEALL,
FAGAN, MINNICH & McKEE, LLP

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May Ann Jernigan
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Applicant's Reply Brief Under 37 C.F.R. § 1.193

Box AF
Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

This is in reply to the Examiner's Answer mailed December 22, 1998, in the above-captioned case.

This reply is warranted to address (i) the Examiner's refusal to enter evidence of nonobviousness of the claims at issue, and (ii) deficiencies associated with the reasons given for rejecting the claims at issue. For the reasons set forth below, Applicant respectfully requests that the previously submitted evidence of nonobviousness be entered and considered in this application. Even if such information is not entered and considered, the reasons argued by the Examiner for rejecting the pending claims are deficient and contrary to 35 U.S.C. § 103.

A. Refusal by the Examiner to Enter and Consider Evidence of Nonobviousness

Accompanying the appeal brief filed on July 23, 1998 in this case, Applicant included evidence pertaining to the nonobviousness of the claimed golf balls, Spalding's Top-Flite® Strata™ golf ball. This evidence concerned the commercial success, praise within the industry, and the extensive and wide-spread adoption of the commercial embodiment of the claimed golf ball. Shortly after filing the appeal brief, Applicant presented additional evidence of nonobviousness to further aid the Examiner in appreciating the nonobviousness of the claimed golf balls. That additional information was submitted, along with Applicant's supplemental showing, on September 28, 1998.

In the Examiner's Answer, the Examiner asserted that such information would not be entered, and thus not considered, in this appeal:

The exhibits filed with the 7/23/98 brief and the supplemental 10/1/98 brief have not been entered. The showing under 37 CFR 1.195 is not deemed sufficient to justify entry of the exhibits. Appellants state that much of the information was available prior to the Appeal but was nonetheless withheld until a greater body of exhibits could be filed. As the material all relates to commercial acceptance and success any additional material not available at the time of appeal would merely appear to have been cumulative to that available at the time of appeal and would not justify the delay in prosecution caused by a first time consideration of such material being undertaken in the examiner's answer.

Page 2 of Examiner's Answer.

The Examiner's refusal to consider this information is contrary to the pronouncement by the Court of Appeals for the Federal Circuit. That court has stated that, "objective indicia of nonobviousness, when present, are invariably relevant to the determination under Section 103." *Litton Systems, Inc. v. Honeywell, Inc.*, 87 F.3d 1559, 1569 (Fed. Cir. 1996) citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). "Objective considerations may often be the most probative and cogent evidence of nonobviousness in the record." *Id.* In fact, the Federal Circuit has instructed that such evidence must be considered. "[E]vidence on secondary considerations must have been considered prior to reaching a conclusion on obviousness/nonobviousness." *DeMaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851

F.2d 1387, 1391 (Fed. Cir. 1988), citing *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 306, 227 USPQ 657, 674 (Fed. Cir. 1985), *cert. denied*, 475 US 1017, 106 S. Ct. 1201, (1986).

Apparently, the reason for the Examiner refusing to enter the evidence, other than the vague reason that "[t]he showing...is not deemed sufficient," is that:

[A]ny additional material not available at the time of appeal would merely appear to have been cumulative to that available at the time of appeal.

See previous quote from page 2 of Examiner's Answer.

Applicant explained the reason for presenting the evidence at issue in Applicant's showing under 37 C.F.R. § 1.195 filed with the appeal brief:

During prosecution of the present application, Applicant and his attorneys began gathering information relating to the commercial success of the Strata™ ball. Since the Strata™ ball was introduced only very recently, around mid-1996, information concerning its commercial success has only become available after that date. Although some of the information submitted with the Appeal Brief was available prior to the appeal of this application, portions of the information were not available until after the filing of the Notice of Appeal on April 20, 1998, i.e. the article entitled, "Full Metal Jacket, Golf ball performance reaches new levels with the advent of metal construction and multiple layers," published in July of 1998 in *Golf Tips*.

It is important and significant in the opinion of Applicant's attorneys, to present information spanning a relatively long period of time, and preferably up to the present time. The article entitled "Full Metal Jacket..." supplements and confirms the abundance of information and rave reviews of the Strata™ published in 1996 immediately after the introduction of the Strata™.

Lastly, the commercial success of the golf ball of the present invention has recently been further highlighted. Specifically, this was the golf ball utilized to win the 1998 Masters® golf tournament and the recent 1998 British Open®.

Page 2 of Applicant's Showing filed July 23, 1998.

A most accurate and objective assessment of this evidence occurs when it is reviewed as a whole. Moreover, Applicant believes that the more recent evidence

pertaining to the commercial embodiment of the present invention golf ball and its use in winning the 1998 Masters® and 1998 British Open® golf tournaments is particularly significant. That information was not available prior to filing of the notice of appeal in this case.

For the foregoing reasons, Applicant respectfully submits that all evidence submitted on July 23, 1998 and September 28, 1998, be considered in determining the patentability of the claims at issue.

At a minimum, the evidence that was not available at the time of filing the present appeal must be admitted and considered. Since the Notice of Appeal was filed in this case on April 20, 1998, Applicants respectfully submit that the article entitled, "Full Metal Jacket, Golf Ball Performance reaches new levels with the advent of metal construction and multiple layers", (Exhibit 17 of the July 23, 1998 appeal) be admitted since that article was published in July of 1998, which was after the Notice of Appeal. Furthermore, the other materials (Exhibits 1-6) of Applicant's Supplemental Showing filed on September 28, 1998 became available after the Notice of Appeal. These materials should be admitted. None of these materials, available after the filing of the Notice of Appeal are "merely cumulative" to the materials that were available prior to this Appeal. The materials that have only recently become available, after the filing of the Notice of Appeal, confirm the rave reviews of the introduction of the Strata™ and illustrate use of this ball in winning the 1998 Masters® and 1998 British Open®, concluded on April 12, 1998 and July 19, 1998, respectively.

B. Examiner's Reasons Presented in the Answer for Rejecting Claims Are Deficient

As will be recalled, the Examiner rejected all claims, i.e. claims 1-13, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 4,431,193 to Nesbitt in view of 5,068,151 to Nakamura. In Applicant's previous appeal brief, it was explained why this rejection is improper and must be reversed.

Separate and apart from the above, there are also numerous deficiencies in the Examiner's Answer as follows.

1. Examiner Ignores the Fact that Nesbitt Teaches the Use of a Low Acid Ionomer

First, on pages 3 to 4 of the Examiner's Answer, the Examiner contends that Nakamura teaches specific types of hard materials that Nesbitt, in the '193 patent, teaches should be used in manufacturing a golf ball:

The primary reference Nesbitt teaches that to manufacture the ball one should use a relatively hard material [for an inner cover layer]. Although Nesbitt only suggests one particular material, it would have been obvious to one of ordinary skill in the art that other known hard materials used in the art would have been suitable for Nesbitt's purpose.

Page 3 of Examiner's Answer (bracketed text added).

The foregoing quoted language appears to be the basis for the Examiner's rejection. The Examiner notes that "Nesbitt teaches that to manufacture the ball one should use a relatively hard material." However, a closer reading of that patent reveals that Nesbitt continues and discloses that in producing a multi-layer golf ball, a first interior layer that is formed about a spherical core, is comprised of a hard, high flexural modulus resinous material such as type 1605 Surlyn® (now designated Surlyn® 8940), col. 2, lines 34-39.

The Examiner ignores the fact that this is a low acid ionomer resin. Thus, in point of fact, Nesbitt teaches the use of a low acid ionomer resin for an interior mantle layer, which is directly contrary to a claimed feature of the present invention golf balls, i.e. that a high acid ionomer be used in such layers. Thus, Nesbitt actually teaches away from the claimed invention.

2. Nakamura Does Not Distinguish Between High Acid and Low Acid

Notwithstanding the previously noted defect, the Examiner's rejection is also flawed for the following reasons. On pages 3-4 of the Office Action, the Examiner states:

Nakamura teaches that one hard material which is known in the art is a high acid ionomer including "10 to 20% by weight of an alpha, beta-unsaturated carboxylic acid." Given that such a hard material is known in the art, and that Nesbitt desires a hard material, it would have been obvious to one of ordinary skill in the art to have utilized such a material to provide the effects desired by Nesbitt. This is

the context in which the secondary reference Nakamura must be viewed. The examiner has not cited Nakamura to show that such materials have heretofore been used in an inner cover layer, but rather to show that such materials are known in the art and are of the type of material desired by Nesbitt in manufacturing his ball.

In the previously quoted passage, the Examiner erroneously states, "Nakamura teaches that one hard material which is known in the art is a high acid ionomer including '10 to 20% by weight of an alpha, beta-unsaturated carboxylic acid'."

According to the present application and as generally understood in the industry, a "high acid ionomer" would not include an ionomer including 10%, or for that matter, 10% to 15%, by weight of an alpha, beta-unsaturated carboxylic acid. A "high acid ionomer" as that term is used in the industry, refers to an ionomer that contains greater than about 16% by weight of a carboxylic acid. This was the specific definition of "high acid ionomer" provided in the present application (see page 12 of the specification).

Furthermore, the Examiner's statement, or rather view as to what Nakamura teaches, actually supports the view that Nakamura does not distinguish between high acid ionomers and low acid ionomers. Nakamura fails to disclose any advantage of using high acid resins (i.e. >16% acid) versus low acid resins. In fact, Nakamura does not distinguish high acid ionomers from low acid ionomers since Nakamura merely describes such ionomers as containing from 5% to 20%, thereby treating them as equivalent to one another.

As previously noted, since Nesbitt teaches the use of a low acid ionomer, one would not be motivated to refer to a reference describing high acid ionomers. If the Nakamura patent were magically placed before a formulator, in combination with the Nesbitt patent, the Nakamura patent still fails to teach the use of a high acid ionomer instead of a low acid ionomer since it treats both as equivalents to one another. Simply put, there is no motivation provided by these patents to utilize a high acid ionomer in an inner layer of a golf ball. For at least these reasons, the Examiner's reliance upon the '151 patent to Nakamura is misplaced.

3. Nakamura Does Not Teach the Use of a "High Acid Ionomer"

Nakamura generally relates to the use of a low acid ionomer, as opposed

to high acid, to produce the outer cover layer of a golf ball. Nakamura briefly suggests that the acid content of the ionomer resin utilized may be of 5% or 10% to 20% by weight. Nakamura fails to disclose any advantage of using high acid resins, i.e. greater than 16% acid, versus low acid resins. In fact, no Example of Nakamura uses greater than 15% acid.

The Examiner however argued that:

Nakamura does not "briefly suggest" the claimed material. The claimed material is recited throughout the Nakamura patent. See the Abstract, Summary of the Invention, Detailed Description of the Invention, and Claims 1 and 5.

Page 4 of Examiner's Answer.

The claimed material, i.e. "a high acid ionomer including at least 16% by weight of an alpha, beta-unsaturated carboxylic acid" is not as the Examiner contends, "recited throughout the patent." The Examiner is confusing the specifically claimed material with the very broad class of materials of ionomers containing 10 to 20% by weight acid. As previously explained, Nakamura does not distinguish between high acid ionomers from low acid ionomers, but instead treats them as equivalents.

4. Mischaracterization of Statement that High Acid Ionomer Resins Were Not Commercially Available Prior to January, 1992

In explaining that Nakamura does not distinguish between the class of ionomers now known as low acid ionomers from the class of ionomers now known as high acid ionomers, Applicant noted that high acid ionomer resins were not commercially available prior to January 1, 1992. Applicant brought this to the Examiner's attention since it further demonstrates that Nakamura cannot be read as distinguishing low acid ionomers from high acid ionomers, since at the time of filing the application which matured into the Nakamura patent¹, the golfing industry and marketplace were not aware of the differences between the performance and properties resulting from such resins.

¹The U.S. application was filed on February 2, 1990, and the Japanese parent patent was filed on February 6, 1989.

Perhaps the Examiner misconstrues the reason for Applicant bringing this matter to the attention of the Examiner, by stating:

As to the "commercial availability" in the U.S., appellant has offered no evidence to back up his argument. Moreover, there is no requirement that a material disclosed by a prior art reference be "commercially available."

Page 4 of Examiner's Answer.

Applicant has not offered such evidence since as far as is known such evidence does not exist. Certainly, the difficulty in proving the absence of something will be appreciated.

Applicant is uncertain as to the Examiner's statement that "there is no requirement that a material disclosed by a prior art reference be commercially available." Applicant never contended such a requirement.

5. Examiner's Reasons for Rejecting Remaining Claims are Deficient

Turning attention to the specific rejection of the remaining claims at issue, for claims 4 and 5, the Examiner argued:

Nesbitt discloses that the thicknesses of the inner and outer layers may be varied as desired, (Col. 2, line 65 - Col. 3, line 25) and with regard to claim 4 discloses the specifically claimed dimensions. Regarding claim 5, it is the examiner's opinion that absent a showing of criticality/unexpected results, the claimed dimensions would have been obvious to one of ordinary skill in the art seeking to obtain a particular flight effect from the golf ball.

Page 4 of Examiner's Answer.

It is respectfully submitted that the Examiner's reading of these claims is oversimplified and ignores the fact that they recite particular aspects of the invention in combination with features in claim 1, from which each of these claims depend.

Claims 4 and 5 are both dependent from independent claim 1 and so, contain all of the recitations of that claim. In addition, these claims recite additional aspects pertaining to particular thickness ranges for the inner and outer cover layers. Claim 4 recites that the inner cover layer has a thickness of about 0.100 to about 0.010 inches and the outer cover layer has a thickness of about 0.010 to about 0.05 inches.

This particular combination of thickness ranges for the covers, particularly when taken in combination with the high acid ionomer aspect of the inner cover layer defined in claim 1, is simply not described or suggested in the Nesbitt and Nakamura patents. Similarly, claim 5 recites a unique combination of specific thicknesses for the inner cover layer and outer cover layer -- the inner cover layer has a thickness of about 0.300 inches and the outer cover layer has a thickness of about 0.375 inches -- which is not taught or suggested in the patents to Nesbitt and Nakamura. This particular aspect, especially when taken in combination with the other previously described aspects called out in claim 1, is in no way described in the cited references. For at least these reasons, claims 4 and 5 are nonobvious and patentable over the cited art.

Regarding claims 6-8, the Examiner argued:

Nesbitt teaches that the outer layer may be formed from a suitable relatively soft material. As the appellant discloses in his specification, (see page 34, first paragraph), suitable soft materials are known in the art. In view of Nesbitt's disclosure it would have been obvious to one of ordinary skill in the art to have utilized such a known material to form the outer layer. This was pointed out to the appellant in the last 4 lines of the 4/8/94 office action. Regarding appellant's C.4. argument [concerning claims 9-11], the same analysis applies with regard to appellant's specification at page 34, last paragraph through page 35 first paragraph.

Page 5 of Examiner's answer (bracketed text added):

Again, the Examiner oversimplifies the claimed subject matter and ignores numerous recitations in these claims. Claim 6 is dependent from claim 1 and so contains all of the recitations of that claim. Claim 6 further recites that the outer layer low flexural modulus ionomer resin includes a blend of hard high modulus ionomer with a soft low modulus ionomer. The high modulus ionomer is recited as a sodium, zinc, magnesium or lithium salt of a copolymer having from 2 to 8 carbon atoms and an unsaturated monocarboxylic acid having from 3 to 8 carbon atoms. Claim 6 further recites the low modulus ionomer being a sodium or zinc salt of a terpolymer of an olefin having 2 to 8 carbon atoms, acrylic acid and an unsaturated monomer of the acrylate ester class having from 1 to 21 carbon atoms. There is absolutely no mention of this combination of components, nor the expressly recited aspects of these components in either of the patents to Nesbitt or Nakamura.

Claims 7 and 8, both of which are dependent from claim 6 and so contain all of its recitations, recite specific proportion ranges for the hard high modulus ionomer resin and the soft low modulus ionomer resin. There is absolutely no mention or even hint of these aspects, and especially the combination of these features, in the Nesbitt and Nakamura patents. For at least these reasons, all of claims 6-8 are non-obvious and patentable over the prior art of record.

Each of claims 9 to 11 is dependent from previously discussed claim 1, and so, each contains the recitations of claim 1. In addition, each claim recites a specific agent for use as the non-ionomeric thermoplastic elastomer that may be used in the outer cover layer. Claim 9 recites the elastomer as a polyester polyurethane. Claim 10 calls for the elastomer to be a polyester elastomer. Claim 11 recites the elastomer as a polyester amide. The particular combinations of features recited in these claims, especially when taken with the aspects called out in claim 1, are simply not described in the prior art.

Concerning claims 12 and 13, the Examiner asserted:

Concerning claims 12 and 13, the appellant has again cited known materials suitable for Nesbitt's purpose. Based on Nesbitt's teaching, these are exactly the materials which the ordinarily skilled artisan would seek to use in manufacturing the golf ball. Therefore appellant's choice of such cannot be considered unobvious. Regarding the particularly claimed modulus, such would obviously have been varied by the ordinarily skilled artisan within the claimed range to obtain a particular flight characteristic. Absent some unexpected result the claimed modulus cannot be seen as unobvious.

Page 5 of Examiner's answer.

Applicant questions the Examiner's improper analysis using hindsight reconstruction and impermissible "obvious to try" reasons of these claims. These claims contain numerous recitations that the cited references simply do not teach.

Claim 12 recites a multi-layer golf ball comprising a spherical core, an inner cover layer molded over the core, and an outer cover layer molded over the spherical intermediate ball to form a multi-layer golf ball. The inner cover layer is recited as including at least 16% by weight of an alpha, beta-unsaturated carboxylic acid. As previously noted, Nesbitt entirely fails to disclose or even suggest incorporating a high

acid ionomeric resin in an inner cover layer. And, Nakamura fails to disclose or even remotely suggest the use of hard, high acid ionomer resins to formulate the inner cover.

In addition, claim 12 further specifically recites that the particular ionomeric resin utilized in the inner cover layer have a modulus of from about 15,000 to about 70,000 psi. Neither Nakamura nor Nesbitt, taken singularly or in combination, teach, describe, or suggest this aspect. Accordingly, the unique combination of these aspects of the inner cover layer, i.e., that it comprise at least 16% of an alpha, beta-unsaturated carboxylic acid, and that it comprise a certain ionomeric resin having a particular modulus, is not taught in either of the patents cited by the Examiner.

Claim 12 further recites and in addition to the foregoing aspects, that the outer cover layer comprise a specific blend of two components. The first component is a sodium or zinc salt of a copolymer having from 2 to 8 carbon atoms and an unsaturated monocarboxylic acid having from 3 to 8 carbon atoms. Neither Nakamura nor Nesbitt, taken individually or in combination, teach, describe or even suggest this aspect. The non-obviousness of this claim is readily apparent in view of this claimed aspect, especially when taken in conjunction with the previously noted features of the inner cover layer.

The second component utilized in the outer cover layer blend, and expressly recited in claim 12, is a sodium or zinc salt of a terpolymer of an olefin having 2 to 8 carbon atoms, acrylic acid, and an unsaturated monomer of the acrylate ester class having from 1 to 21 carbon atoms.

It is indisputable that the references relied upon by the Examiner entirely fail to teach or even suggest this aspect, and this aspect taken in combination with the foregoing features of the inner cover layer and the other component utilized in the outer cover layer blend.

Notwithstanding the nonobviousness of the noted subject matter recited in claim 12, claim 12 further recites yet another aspect of the claimed golf ball -- that the outer cover layer have a modulus in the range of from about 1,000 to about 30,000 psi. Neither of the patents cited by the Examiner teach this aspect. And, neither of the patents teach, or even remotely hint at, a multi-layer golf ball having the unique combination of features recited in claim 12 -- that the inner cover layer comprise an ionomeric resin including at least 16% of an alpha, beta, unsaturated carboxylic acid,

that the ionomeric resin of the inner cover layer has a modulus of from about 15,000 to about 70,000 psi, that the outer cover layer comprises a blend of (i) a sodium or zinc salt of a copolymer having from 2 to 8 carbon atoms and an unsaturated monocarboxylic acid having from 3 to 8 carbon atoms and (ii) a sodium or zinc salt of terpolymer of an olefin having 2 to 8 carbon atoms, acrylic acid, and an unsaturated monomer of the acrylate ester class having from 1 to 21 carbon atoms, and that the outer cover layer has a modulus in a range of about 1,000 to about 30,000 psi. Clearly, claim 12 recites patentable subject matter.

Claim 13 recites a multi-layer golf ball comprising a spherical core, an inner cover layer, and an outer cover layer. Claim 13 calls for the inner cover layer to comprise an ionomeric resin that includes about 17% to about 25% by weight of an alpha, beta-unsaturated carboxylic acid. Claim 13 further calls for the particular ionomeric resin to have a modulus of from about 15,000 psi to about 70,000 psi. This aspect is not described in either the Nakamura or Nesbitt patents. The combination of this aspect and the particular proportion of the certain ionomeric resin called for in claim 13 is not described in the Nakamura or Nesbitt patents.

Claim 13 also recites that the outer cover layer comprises a specific type of non-ionomeric thermoplastic selected from a group of polyester elastomer, polyester polyurethane and polyester amide. Claim 13 additionally recites that the outer cover layer have a modulus in the range of from about 1,000 to about 30,000 psi. Again, there is no mention in either of the two references relied upon by the Examiner of an outer cover layer comprising one or more of these types of non-ionomeric thermoplastics, having a modulus within this recited range, in combination with an inner cover layer that comprises an ionomeric resin that includes a certain amount of an alpha, beta-unsaturated carboxylic acid and that has a specific modulus. It simply cannot be said that claim 13 recites obvious subject matter.

C. Conclusion

It appears, with all due respect to the Examiner, that the present rejection is not based upon established principles under 35 U.S.C. § 103 and court and Board decisions applying those principles, but instead, is based upon a distorted reading of the prior art, hindsight reconstructions, and obvious to try reasoning of the claimed invention

golf ball.

For example, the Examiner concludes the rejection of all claims in the present application by stating:

In conclusion, it is the examiner's opinion that the appellant has taken a known ball, (Nesbitt) and merely used known materials suitable for Nesbitt's purpose to manufacture the ball. This is completely in accordance with what Nesbitt teaches. That appellant has chosen materials not available at the time of the Nesbitt patent, but which were known prior to the instant application, and clearly among the type contemplated by Nesbitt's invention, is not considered unobvious.

Applicant and its attorneys have carefully crafted the pending claims to define patentable subject matter. The rejection of these claims for the Examiner's reasons, is improper and must be reversed.

Accordingly, it is respectfully requested that the Examiner's 35 U.S.C. § 103 rejection be reversed.

Respectfully submitted,
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